



IN THE
Supreme Court of the United States
OCTOBER TERM, 1976
No. 76-1575

CONTROL DATA CORPORATION,

Petitioner,

—v.—

TECHNITROL, INC.,

Respondent.

**BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI TO THE
COURT OF APPEALS FOR THE FOURTH CIRCUIT**

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This brief is submitted on behalf of Technitrol, Inc., plaintiff in the patent infringement action from which the present proceeding arose, who hereinbelow will be called "patentee."

I. Introduction

There is no basis for issuance of a writ of certiorari here.

The basic circumstance urged by petitioner is fictional and even if the questions raised were decided in petitioner's favor, this would not be determinative of the ultimate issue.

Moreover, there is no special and important reason for granting review of the decision below. Rule 19(1). As is shown below:

1. There is no conflict with the decision of another court of appeals on the same matter.

2. There is no important question of federal law which has not been, but should be, settled by this Court.

3. There is no conflict with any applicable decision of this Court.

Petitioner seeks appellate review of a decision on claim construction of a patent whose validity has not yet been tried. One of the two separate reasons for the Fourth Circuit Court's vacating of the district court's grant of summary judgment is a pure matter of claim construction. The other separate reason is based on the clear meaning of the third paragraph of 35 U.S.C. § 112 after a very scholarly analysis of applicable precedents and articles. What petitioner proposes is that this Court effectively amend that paragraph by adding an additional requirement in conflict with this Court's decision in *U.S. v. Adams*, 383 U.S. 39 (1966).

Before going into these matters, the misleading nature of petitioner's statement of supposed facts requires restating the case.

II. Restatement of the Case

(A) *Prior to 1969 Patentee Asserted That Claim 19 Included the Reset Feature and the Court of Claims' Patent Commissioner Agreed That It Does*

Only representative Claim 19 was addressed by the Fourth Circuit Court. (Supplemental Appendix (herein "Supp. A."), pp. 5-6.) Patentee has *always* asserted that Claim 19 included the automatic memory reset feature as vital to solve the position volatility problem.

In 1971, the Court of Claims held that each claim of the patent was freely licensed to the United States unless the

claim included the reset feature. It is misleading for petitioner to state (at Pet. p. 6, emphasis added) that patentee "*then engaged in an assertion that the claims (except for one) included the reset feature.*"

Patentee had asserted that Claim 19 included the reset feature *before* the Court of Claims' Patent Commissioner concluded *in 1969* that it be so construed. The Commissioner first stated that:

Claim 19 is representative, the pertinent clause stating, "• • • means for producing from said recorded pulses [on the clock disk] different successively-occurring register-selection voltage combinations representative respectively of said register • • •"

Technitrol, Inc. v. United States, 161 U.S.P.Q. 51, 53 (Ct. Cl. Comm'r 1969). (Original Appendix (herein "Orig. A."), p. 42.) Then he concluded, 161 U.S.P.Q. at 55, (Orig. A. pp. 44-45, emphasis added):

It is the patent claims which define the legally protected subject matter of a patent. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 409 (1908); *White v. Dunbar*, 119 U.S. 47, 51 (1886). The specification and drawings describe the invention to those skilled in the art and may be looked to in construing and understanding the scope of the claims. *Smith v. Snow*, 294 U.S. 1, 24 USPQ 26 (1935). Defendant's contention of license is bottomed on its interpretation of the claims as not including the memory reset feature, i.e., the two-channel clock disk and associated counters. According to defendant, this feature is not expressly recited in the claims, thus forms no part of the legally protected subject matter of the

patent. Plaintiff concedes the memory reset feature is not expressly recited, but says the "means" clauses, above noted, directed to the register-selection part of the system include the two-channel clock disk. We agree with plaintiff. "Means" clauses are expressly permitted by the patent statute, 35 U.S.C. § 112, which says that an "element in a claim for a combination may be expressed as a means * * * for performing a specified function without the recital of structure * * * in support thereof, and such claim shall be construed to cover the corresponding structure * * * described in the specification and equivalents thereof." *Ellicott Mach. Co. v. United States*, 186 Ct. Cl. 655, 644-5, 405 F.2d 1385, 1390, 160 USPQ 753 (1969); *Stearns v. Tinker & Rasor*, 252 F.2d 589, 597, 116 USPQ 222, 228 (9th Cir. 1957). The register-selection function of the claimed system is performed, in part, by the two-channel clock disk which is "corresponding structure described in the specification" within the meaning of the statute."¹

(B) Petitioner's Questions (1), (2) and (4) Are Specious Because They Are Not Based on Fact

Petitioner's assertions that "the court below makes new law in permitting patentee to alter the scope of its patent

¹ The Fourth Circuit Court found the Commissioner's reasoning to be persuasive. In referring to the opinion of the full Court of Claims, the circuit court stated: "While it is true that the court did not wholly follow his recommendations, it decided the case on other grounds and specifically did not decide the issue of whether the automatic reset feature was included in the claims of the patent as just above stated. We neither accept nor reject finally the commissioner's construction of claims although his reasoning is persuasive." (Supp. A. pp. 7-8, n. 3.)

claims . . ." and "to change the scope of the patent claims" (Pet. pp. 4-5), and similar assertions, are therefore not true. Thus the "factual" basis of Questions (1) and (2) is incorrect so they are specious questions.

Question (4) is based on a misleading statement that "patentee contends that the other claims having recitations of the same function [as Claim 16 which excludes the reset feature] do include such [reset] feature." (Emphasis added.) The language of Claim 16 is completely different from the language of Claim 19. That is because Claim 16 originated in another patent application (Schmidt) and Claim 16 was awarded to patentee in settlement of an interference priority proceeding in the U.S. Patent Office. (Orig. A. p. 42.) Claim 16 cannot include the reset feature because it came from the Schmidt patent application, which petitioner admits does not have the reset feature. (Pet. p. 6.) So Question (4) is specious.

That leaves only Question (3). It can be more accurately restated as follows.

III. Restatement of Question (3)

Whether a patent claim of the "means plus function" type is valid under the second paragraph of 35 U.S.C. § 112 as particularly pointing out and distinctly claiming an invention where a feature of the invention is structural means described in the specification of the patent and the function of the means is specified in the claim so that under the third paragraph of 35 U.S.C. § 112 such claim "shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof?"

IV. Argument

(A) *The Questions Presented Are Not a Special and Important Reason for Granting Review of the Decision Below Under Rule 19(1)*

It is true, of course, that patent claims must be definite. So there is no conflict with any applicable decision of this Court. (Pet. pp. 10-13.)

35 U.S.C. § 112, paragraph two, requires that the "specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter *which the applicant regards as his invention.*" (Emphasis added.) As noted by petitioner on page 13 and in its note 10, the Fourth Circuit Court found that the applicants *intended* to claim the reset feature in their specification; i.e., that is what they *regarded* as part of the subject matter of their invention even *if*, as petitioner incorrectly argues, the feature is not necessary to perform the specified function. The circuit court, however, found that it is necessary as is reflected in its statement that: "we think the invention would not work in the manner conceived by the inventor if it were position volatile." (Supp. A. p. 13.) So there is no error in the court below. (Pet. pp. 13-16.)

Petitioner argues (at p. 16) that the "rule of law which should be settled by this Court and applied to this case is that a 'means plus function' claim does not include features in the specification which are not necessary to the function actually recited in the claim. There must be a causal connection between the recited function and the features included within the ambit of the claim." Then it adds in a *non sequitur* that there is no causal connection because patentee only wanted to avoid the license defense set

up in the Court of Claims (a case that was admittedly settled).

Petitioner's argument collapses for any one of four reasons. (1) Patentee has always asserted that Claim 19 covered the reset feature, so the license-avoidance theory is specious. (2) The circuit court found that there is a causal connection. (Supp. A. p. 13.) (3) Patentee agrees that the third paragraph of 35 U.S.C. § 112 does not modify the second, but what does that have to do with any additional requirement for a causal connection? (4) Patentee regards the reset feature as *necessary to* and covered by Claim 19, and has particularly pointed it out and distinctly claimed it in the permissible language of the third paragraph, as the circuit court found.

But this question of claim construction is hardly an important question of federal law which should be settled by this Court.³ That is especially so when the facts don't even support petitioner's theory.

Moreover, there is no conflict with the decision of another court of appeals *on the same matter*. The *Kaiser* case does not concern the third paragraph of 35 U.S.C. § 112. (Pet., pp. 18-21.)

³ Particularly so because the circuit court in Part I of its opinion separately construed the term "representative" in clause 2 of Claim 19 as including the reset feature without recourse to 35 U.S.C. § 112, third paragraph. (Supp. A. pp. 8-10; note that the heading "II" is omitted after the first paragraph on p. 10.)

(B) *Petitioner's Argument That a Key Feature of the Invention Must Be Expressly Recited to Prevent Claim Indefiniteness Is Contrary to This Court's View in Adams*

In *United States v. Adams*, 383 U.S. 39 (1966), this Court, in upholding a patent, stated (383 U.S. at 48-49):

[T]he fact that the Adams battery is water-activated sets his device apart from the prior art. It is true that Claims 1 and 10, *supra*, do not mention a water electrolyte, but, as we have noted, a stated object of the invention was to provide a battery rendered serviceable by the mere addition of water. While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, *Burns v. Meyer*, 100 U.S. 671, 672 (1879); *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116 (1895); it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention, *Seymour v. Osborne*, 11 Wall. 516, 547 (1870); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 47 USPQ 345 (1940); *Schering Corp. v. Gilbert*, 153 F.2d 428 (1926).

Here, the reset feature sets the patentee's system apart in solving the position volatility problem. It is true that Claim 19 does not expressly mention the reset feature but, as the circuit court noted, "the problem to be solved, as acknowledged by all, was shown to be position volatility, [and] we think the invention would not work in the manner conceived by the inventor if it were position volatile. . . . Thus, by reference to the specifications in accordance with paragraph 3 of § 112, we think the clock disk and its function, which amounts to the reset feature, is covered as a

corresponding structure or act as a part of the claim and helps serve to prevent invalidity for indefiniteness." (Supp. A. pp. 13-14.)

Petitioner's argument that the reset feature has to be *expressly* recited to prevent claim indefiniteness is contrary to this Court's view in *Adams*.

(C) *The Fourth Circuit Court Correctly Construed Claim 19 in Holding That the Reset Feature Is Covered As Corresponding Structure Under Paragraph Three of 35 U.S.C. § 112*

The correctness of the circuit court's construction based on its scholarly analysis of 35 U.S.C. § 112 speaks for itself (at Supp. A. pp. 13-15):

Referring back to the first part of this opinion in which the problem to be solved, as acknowledged by all, was shown to be position volatility, we think the invention would not work in the manner conceived by the inventor if it were position volatile. This is so because the voltage combinations would not be representative respectively of the registers at each necessary place in the system in an apparatus which was position volatile. The voltage combinations in such a position volatile apparatus might well be not so representative after power failure or cutoff as we have before described.

Considering that clause 2 of claim 19 is in one of the permissible forms of claiming under paragraph 3 of § 112, since it expresses a "means or step for performing a specified function," we think the specified function is the production and transmission to necessary places in the system of voltage combinations "representative respectively of said registers" and not of

something else. That being true, it is not necessary that the claim recite a "structure, material, or acts in support thereof," for it "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." § 112, paragraph 3.

The clock disk and reset feature is mentioned at various places throughout the specifications, but for our present purpose we need mention only one. Column 4, line 33, contains the following language:

"The one pulse per revolution output supplied from the clock disk 1 through amplifier *a1* is used to initially set the counters so that the registers on the disks will always remain the same relation with the pulses on the clock disk as checked by counters *b* and *c*, even though the power be shut off and later turned on with the counters coming up containing arbitrary counts."

Thus, by reference to the specifications in accordance with paragraph 3 of § 112, we think the clock disk and its function, which amounts to the reset feature, is covered as a corresponding structure or act as a part of the claim and helps serve to prevent invalidity for indefiniteness. See opinion of the Patent Commissioner, 164 USPQ at 55-56. We think our construction of the language used is consistent with *Continental Paper Bag Company* (the claims measure the invention); with *Lundberg* (we have not diminished the effect of the second paragraph by reference to the third paragraph of § 112); with *Knowlton* (in permissible claiming, we have construed the language of the claim as directed by the third paragraph of § 112); and with *Stearns*

(the structure is recited in the specifications, although it need not as well be in the claim).

We are therefore of opinion that the district court erroneously construed the claims for the reasons set forth just above, as well as those in Part I of this opinion.

V. Conclusion

Petitioner ends (p. 21) where it began—with fiction, not fact. Patentee has always regarded the automatic memory reset feature as necessary to the Claim 19 invention and as covered by Claim 19. There is no admission to the contrary.

The petition should be denied.

Respectfully submitted,

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